



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/403,107	10/14/1999	PETER KUFER	3816-4000	6846

7590

08/27/2002

John W. Freeman, Esq.
Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110

EXAMINER

HELMS, LARRY RONALD

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 08/27/2002

24

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/403,107

Applicant(s)

KUFER ET AL.

Examiner

Larry R. Helms

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-22, 28, 29, 31, 32 and 34-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 18-22, 28, 29, 31, 32, 34-75 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The response filed 7/24/02 to the restriction requirement mailed 3/28/02 has been noted, however, the restriction requirement mailed 3/28/02 has been vacated. A new restriction requirement is set forth below.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 18-22, 28, 29, 31 in part, 32, 34-67, 68, drawn to an anti-human antigen receptor, classified in class 530, subclass 387.1. If Group I is elected then claim 31 will be examined to the extent the epitope is SEQ ID NO:29.
 - II. Claims 18-22, 28, 29, 31 in part, 32, 34-67, 69, drawn to an anti-human antigen receptor classified in class 530, subclass 387.1, If Group II is elected claim 31 will be examined to the extent the epitope SEQ ID NO:32.
 - III. Claims 18-22, 28, 29, 31 in part, 32, 34-67, 70, drawn to an anti-human antigen receptor, classified in class 530, subclass 387.1. If Group III is elected claim 31 will be examined to the extent the epitope is SEQ ID NO:34
 - IV. Claims 18-22, 28, 29, 31 in part, 32, 34-67, 71, drawn to an anti-human antigen receptor, classified in class 530, subclass 387.1. If Group IV is

elected claim 31 will be examined to the extent the epitope is SEQ ID NO:35.

V. Claims 18-22, 28, 29, 31 in part, 32, 34-67, 72, drawn to an anti-human antigen receptor, classified in class 530, subclass 387.1. If Group V is elected claim 31 will be examined to the extent the epitope is SEQ ID NO:80.

VI. Claims 18-22, 28, 29, 31 in part, 32, 34-67, 73, drawn to an anti-human antigen receptor, classified in class 530, subclass 387.1. If Group VI is elected claim 31 will be examined to the extent the epitope is SEQ ID NO:81.

VII. Claims 18-22, 28, 29, 31 in part, 32, 34-67, 74, drawn to an anti-human antigen receptor, classified in class 530, subclass 387.1. If Group VII is elected claim 31 will be examined to the extent the epitope is SEQ ID NO:98.

VIII. Claims 18-22, 28, 29, 31 in part, 32, 34-67, 75, drawn to an anti-human antigen receptor, classified in class 530, subclass 387.1. If Group VIII is elected claim 31 will be examined to the extent the epitope is SEQ ID NO:100.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I-VIII represent separate and distinct products which bind to separate and distinct polypeptides. The anti-human receptors of each group bind to a separate and distinct sequence claimed. An anti-human antigen receptor of one group

Art Unit: 1642

would not bind to the same epitope of another group. Thus, the epitopes are distinct and as such the anti-human antigen receptors would be separate and distinct. Art on one anti-human antigen receptor that bound one epitope would not be art on another which bound a separate epitope. The examination of all groups would require different searches in the U.S. Patent shoes and the scientific literature and would require the consideration of different patentability issues. Thus the inventions I-VIII are patentably distinct.

NOTE: It is noted that claim 32 recite sequences that in Figures 6-9, however the Figures do not contain SEQ ID Nos. It is requested that the SEQ ID Nos be placed in the claims for a proper search. Also It is unclear which epitope the anti-human receptor in claims 22 and 32 binds. It is requested that applicant disclose which epitope and which proper group claims 22 and 32 would be placed in give the above restriction requirement.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different classifications, restriction for examination purposes as indicated is proper.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

Art Unit: 1642

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry R. Helms, Ph.D., whose telephone number is (703) 306-5879. The examiner can normally be reached on Monday through Friday from 7:00 am to 4:30 pm, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

7. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 308-4242.

Respectfully,
Larry R. Helms Ph.D.
703-306-5879

A handwritten signature in black ink, appearing to be 'L. Helms', written in a cursive style.